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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/594,794	06/16/2000	Yoshihito Mizuta	2000 0757A	9888

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EXAMINER	
JOLLEY, KIRSTEN	

ART UNIT	PAPER NUMBER
1762	

DATE MAILED: 12/03/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/594,794	MIZUTA, YOSHIHITO	
	Examin r	Art Unit	
	Kirsten C Jolley	1762	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *14 October 2003*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *24-28,30-33,35-37,39,40,42 and 45-48* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *24-28,30-33,35-37,39,40,42 and 45-48* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☒ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

13)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

a) ☐ The translation of the foreign language provisional application has been received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ .
4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: .

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on October 14, 2003 has been entered.

Response to Amendment

2. The 35 USC 112, 2nd paragraph rejections set forth in the final Office action have been withdrawn in response to Applicant's amendments to the claims.

3. Additionally, the 35 USC 102(b) and 103(a) rejections over JP 61-005981 A have been withdrawn, however it is noted that the claims are rejected over the prior art teaching of Watanabe et al. instead because Watanabe et al. better illustrates and explains the process of JP '981.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an

international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. Claims 30-31, 33, 35, 37, 42, and 45-46 are rejected under 35 U.S.C. 102(e) as being anticipated by Watanabe et al. (US 6,022,438).

As to claim 45, the Background section in column 1 of Watanabe et al. discusses the prior art process of JP 61-5981, and illustrates the process in Figure 6. The process described and illustrated by Watanabe et al. includes the steps of: supporting a transfer film on a surface of a transfer liquid by floating; downwardly immersing a loop shaped workpiece in the transfer liquid so as to transfer the transfer film to a surface of the loop shaped workpiece such that a plane of the surface of the transfer liquid at a transfer initiating site extends through the loop shaped workpiece; moving the loop shaped workpiece along the loop shaped direction in which the workpiece extends at the transfer initiating so as to continuously immerse the loop shaped workpiece while maintaining the attitude of the workpiece the same such that a circumference of a cross section of the loop shaped workpiece, taken in the thickness direction of the loop shaped workpiece, is substantially concurrently contacted with the transfer film at the transfer initiating site; and moving at least one of the workpiece and the transfer film during downwardly immersing.

Figure 6 illustrates that a plane of the surface of the transfer liquid at a transfer initiating site extends through the loop shaped workpiece because the figure shows that the transfer liquid level is above the entire thickness of the workpiece and is illustrated as being slightly in the middle of the loop, thus the plane of the transfer liquid "extends through the loop shaped workpiece." It is noted that because the prior art process starts by immersing the loop shaped workpiece in an upright position directly down into the transfer liquid, the transfer initiating site

is the bottom-most surface of the loop shaped workpiece (see Figure 6). A cross section of the workpiece taken in the thickness direction is substantially concurrently contacted with the transfer film at the transfer initiating site because the entire workpiece in the thickness direction (at the transfer initiating site - illustrated in Fig. 6) is submerged in the transfer liquid, therefore the circumference of the cross section is substantially concurrently contacted with transfer film. While Figure 6 does not illustrate the transfer film wrapping around the thickness of the workpiece on the front and back sides of the workpiece, such would necessarily happen since the transfer liquid flows up and around the bottom of the workpiece. Finally, since the workpiece of Figure 6 and the prior art is maintained in an upright position, the attitude of the workpiece is maintained.

As to claim 30, it is noted that the claimed range of plus or minus 90 degrees is inclusive of 0 degrees. The prior art process described in Watanabe et al. and illustrated in Figure 6 has a deflection angle of 0 degrees, i.e., the plane in which the loop shaped direction extends coincides with the plane in which the relative movement direction of the transfer film is set.

As to claims 31 and 35, the immersion attitude angle of the prior art process described by Watanabe et al. is 90 degrees because the loop shaped workpiece is immersed in a vertical, upright position which forms a 90 degree angle between the plane in which the loop shaped direction extends and the plane of the surface of the transfer liquid.

As to claims 33, 37, and 42, the prior art process discussed at col. 1, lines 5-34 produces a steering wheel component with a joint line formed on the most inner portion of the steering wheel, not on the rear surface of the steering wheel. However, Watanabe et al.'s Background section also describes a variation of the above-mentioned prior art process whereby the joint line

is formed at the rear surface of the steering wheel (col. 1, line 41 to col. 2, line 18). While this process results in pattern-distortion and pattern-missing in some regions, Watanabe et al. none-the-less discloses the use of such a process.

As to claim 46, the prior art process of Watanabe et al. (described at col. 1, lines 5-34 and in Figure 6) has a transfer film which laps on the workpiece to form a joint line. Also in this process, a line normal to a direction of relative movement of the transfer film substantially conforms to the circumference of the section of the workpiece in the thickness direction.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

7. Claims 24-28, 32, 36, 39-40, and 47-48 are rejected under 35 U.S.C. 103(a) as being unpatentable over Watanabe et al. (US 6,022,438).

As to claim 24, Watanabe et al. does not specifically teach that the prior art process described in col. 1, lines 5-34, with respect to Figure 6 supplies the transfer film at a feed rate. It would have been obvious for one having ordinary skill in the art, having seen the Watanabe et al. reference, to have supplied the transfer film from a roll at a set feed rate in order to increase efficiency by always having a supply of transfer film instead of repeatedly replacing cut sheets of it. Further, the prior art does not teach setting the relative movement speed so that an immersion rate of the loop shaped workpiece and a feed rate of the transfer film are maintained substantially

equal. However, it is the Examiner's position that it would have been obvious for a skilled artisan to have set the immersion rate and feed rate to be substantially equal because if the immersion rate was faster than the feed rate, the workpiece would pull on the transfer film and thus form a distorted and pulled film pattern, or alternatively if the feed rate was faster than the immersion rate, the transfer film would bunch up at the workpiece and thus form a distorted and bunched film pattern on the workpiece.

As to claim 25, it is noted that the claimed range of plus or minus 90 degrees is inclusive of 0 degrees. The prior art process described in Watanabe et al. and illustrated in Figure 6 has a deflection angle of 0 degrees, i.e., the plane in which the loop shaped direction extends coincides with the plane in which the relative movement direction of the transfer film is set.

As to claim 26, the immersion attitude angle of the prior art process described by Watanabe et al. is 90 degrees because the loop shaped workpiece is immersed in a vertical, upright position which forms a 90 degree angle between the plane in which the loop shaped direction extends and the plane of the surface of the transfer liquid.

As to claims 27, 32, 36, and 39, while the prior art process of Watanabe et al. does not describe a transfer-not-required portion, the invention of Watanabe et al. does describe portions of the steering wheel where transfer is not required, for example grip parts covered with leather and spoke-connecting portions. It would have been obvious for one having ordinary skill in the art to have initially immersed the steering wheel component of Watanabe et al.'s prior art process at the transfer-not-required portion because the prior art process evenly applies transfer film to the entire substrate surface, therefore the location of initial immersion does not affect the final product.

As to claims 28 and 40, the prior art process discussed at col. 1, lines 5-34 produces a steering wheel component with a joint line formed on the most inner portion of the steering wheel, not on the rear surface of the steering wheel. However, Watanabe et al.'s Background section also describes a variation of the above-mentioned prior art process whereby the joint line is formed at the rear surface of the steering wheel (col. 1, line 41 to col. 2, line 18). While this process results in pattern-distortion and pattern-missing in some regions, Watanabe et al. none-the-less discloses the use of such a process.

As to claims 47-48, the prior art process of Watanabe et al. (described at col. 1, lines 5-34 and in Figure 6) has a transfer film which laps on the workpiece to form a joint line. Also in this process, a line normal to a direction of relative movement of the transfer film substantially conforms to the circumference of the section of the workpiece in the thickness direction.

Response to Arguments

8. Applicant's arguments filed April 11, 2003 have been fully considered but they are not persuasive. With respect to the JP '981 reference, Applicant states that "if the transfer initiating site is illustrated towards the right of the steering wheel, it seems clear that the transfer begins at the right side, and only manages to contact all of the surfaces, if ever, halfway along the range of contact with the transfer film on the liquid." It is the Examiner's position that the transfer initiating site is not at the right of the steering wheel, but rather at the bottom of the steering wheel since transfer initiates as the steering wheel is lowered, vertical and upright, onto the transfer film. At this transfer initiating site, the transfer film substantially concurrently contacts a circumference of the loop shaped workpiece because the bottom portion of the steering wheel is

submerged in the transfer liquid to a depth greater than the thickness of the bottom-most portion of the steering wheel, as illustrated in Figure 6 of Watanabe et al. which describes the JP '981 process.

Conclusion

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kirsten C Jolley whose telephone number is 703-306-5461 before December 10, 2003, and will be 571-272-1421 after December 10, 2003. The examiner can normally be reached on Monday to Thursday and every other Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Shrive P Beck can be reached on 703-308-2333 before December 10, 2003, or 571-272-1415 after December 10, 2003. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1193.

Kirsten C Jolley
Patent Examiner
Art Unit 1762

kcj